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Filing date: **09/27/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|------------------------|---|
| Proceeding | 79152818 |
| Applicant | Breitling SA |
| Applied for Mark | MERLIN |
| Correspondence Address | GLENN A GUNDERSEN DECHERT LLP CIRA CENTRE 2929 ARCH STREET PHILADELPHIA, PA 19104-2808 UNITED STATES trademarks@dechert.com, glenn.gundersen@dechert.com, jacob.bishop@dechert.com |
| Submission | Supplemental Brief |
| Attachments | MERLIN -- Supplemental Reply Brief.pdf(4204154 bytes) |
| Filer's Name | Jacob Bishop |
| Filer's e-mail | trademarks@dechert.com, glenn.gundersen@dechert.com, daniel.hope@dechert.com |
| Signature | /Jacob Bishop/ |
| Date | 09/27/2016 |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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|---------------------------|---|----------------|
| In re Application of: | : | |
| Breitling SA | : | |
| | : | Fred Carl III |
| | : | Law Office 108 |
| Mark: MERLIN | : | |
| | : | |
| Serial No.: 79/152,818 | : | |
| Filing Date: July 7, 2014 | : | |

APPLICANT’S SUPPLEMENTAL REPLY BRIEF

Applicant Breitling SA respectfully submits this supplemental brief in response to the examining attorney’s September 7, 2016 reply brief, in which the examining attorney granted Applicant’s request to amend the identification of goods in the present application, but maintained the Section 2(d) refusal based on the mark MERLIN (Reg. No. 4,483,252), registered by Merlin Entertainments Group Operations Limited (“Registrant”).

The examining attorney has now submitted the following additional evidence to support his stance that watches and clothing are typically sold under the same marks: (1) five third party registrations for the marks PRESELF, SOYA GIFT, ILMATIC, YUMMY GUMMY, and PRR, all of which cover both watches and clothing, and (2) “real-world” web evidence that allegedly shows use of the marks JUSTICE, FOSSIL, TAG HEUER, and AMERICAN EAGLE, as well as Applicant’s own BREITLING mark, on both watches and clothing.

With respect to the third party registrations, the examining attorney has again failed to show that consumers actually encounter the PRESELF, SOYA GIFT, ILMATIC, YUMMY GUMMY, and PRR marks being used in the marketplace for both watches and clothing – all the examining attorney has shown is that there are five additional use-based registrations that cover

both watches and clothing. As shown in the attached printouts from the USPTO website, three of the five registrations plainly do not support the examining attorney's assertions:

- The PRESELF and SOYA GIFT registrations cover jewelry as well as watches, and the Class 14 specimens of use submitted to the USPTO only show use of the marks on jewelry.
- The PRR registration does not show use of PRR as a brand name for watches and clothing at all—the mark in the registration is the logo for the now-defunct Pennsylvania Railroad, and the supporting specimens show use of the mark on souvenirs, rather than a brand name for watches and clothing.

Notwithstanding the foregoing, the examining attorney states in Footnote 6 of his brief that the fact that these registrations were “reviewed for use by the examining attorney prior to registration” is sufficient to show that consumers actually encounter the marks being used for both groups of goods. However, neither of the bases he cites for this conclusion actually support this statement.¹

Even assuming that these five new registrations (and the nine registrations the examining attorney previously submitted) suggest that watches and clothing are goods that *could* emanate

¹ The examining attorney cites *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6, which actually supports *Applicant's* point:

“Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, **although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them**, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source.”

(Emphasis added.) The examining attorney also cited TMEP 1207.01(d)(ii), which merely indicates that an examining attorney need not prove actual confusion in order to issue a likelihood of confusion refusal under Section 2(d) of the Trademark Act.

from a single source,” the examining attorney has provided just fourteen examples of instances in which the same mark has been registered for both Class 14 watches and Class 25 apparel—a miniscule number considering there are over 49,000 active federal Class 14 marks and well over 220,000 active federal Class 25 marks. The examining attorney’s examples are also just a fraction of the nearly 40 instances Applicant has cited in which the same mark is registered by different parties for Class 14 watches and Class 25 apparel.

The examining attorney also submits what he refers to as “real-world” evidence to support the refusal, but none of this evidence is reliable. Some of the images appear to be taken from web pages, but there are no URL addresses or dates. Others are random images of products, with no indication of where the images came from, whether they are images of products that are offered for sale to American consumers, or any other context. This evidence should be disregarded on the basis that the examining attorney has not documented where any of it came from. However, even if the Board chooses to consider this evidence, it does not show the same mark used on both watches and clothing.

Most notably, the examiner claims that "applicant itself is using its house brand BREITLING on both watches and clothing", but the examining attorney has no basis for making this assertion. He has submitted what appears to be an excerpt from Applicant’s website showing BREITLING watches, but he has not shown applicant using its mark on clothing on its website. Instead, he has submitted a page entitled "The Breitling Museum On Line". The image is too small to determine whether this page in fact shows clothing bearing the BREITLING mark, and if it does, it’s not clear whether the clothing shown is genuine, vintage, unauthorized,

or counterfeit. It is clear, however, that this website has nothing to do with Applicant, because if one enlarges the heading, it reads as follows:



One might guess from the broken English that this website originates outside the U.S., and is irrelevant on that basis. However, it should have been obvious to the examining attorney that this site is not a reliable source of genuine or current merchandise, and that it is plainly inappropriate for an examining attorney to base a refusal to register on such evidence.

The Board has not permitted Applicant to submit its own evidence in rebuttal, so Applicant is unable to document the shortcomings in the rest of the examining attorney's evidence. However, it is plain from the face of that evidence that it is unreliable, not authoritative, does not support the examining attorney's position, and should be disregarded:

- The examiner has submitted a page showing shorts that bear the mark JUSTICE, and another page showing three watches sold under the marks GO FOR IT, DESTINATION, and RHINESTONE CRITTER. There's no indication of what website these images came from, or whether it is a U.S. website, but they do not show clothing and watches sold under the

same mark. There is also an image of a watchface bearing a JUSTICE logo, but it appears on a blank page, with no indication or explanation of where it came from.

- The examiner has submitted a page bearing the FOSSIL mark showing watches, and another page also bearing the FOSSIL mark, showing two wool caps identified as being sold under the mark WOOL AND GANG. There's no indication of what website these images came from, or whether it is a U.S. website, but they do not show clothing and watches sold under the same mark.
- The evidence with respect to TAG HEUER consists of three images on blank pages, with no indication of where these images were found. In one image, the mark appears on a watchface. Another image is a portion of a polo shirt, and the third shows a t-shirt on which the TAG HEUER logo appears to have been superimposed.



Applicant's counsel also serves as TAG Heuer's U.S. trademark counsel, and can verify to the Board that neither of these clothing images came from TAG Heuer's website. Our web search indicates that the polo shirt image comes from a website at Vintagearticle.com,

located in an unknown country, which offers to reproduce many companies' logos on a variety of merchandise. The t-shirt comes from Expensivemenswatchesme.blogspot.com, the text of which is primarily in Indonesian. There is no reason to assume that any of this merchandise is authorized or available in the U.S., and it provides no support to the examining attorney's basis for refusal.

- The final two pages show four watches and a shirt, each identified as "AEO", with no indication of what website these images came from, or whether it is a U.S. website, and no legible brand names on the watch faces.

In sum, although the examining attorney labels this "real world" evidence, none of it is reliable or authoritative, and none of it is appropriate as the basis for a refusal to register.

Date: September 27, 2016

Respectfully submitted,

/Glenn A. Gundersen/

Glenn A. Gundersen

Jacob Bishop

DECHERT LLP

Cira Centre

2929 Arch Street

Philadelphia, PA 19104-2808

Attorneys for **Breitling SA**



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Preself

Word Mark PRESELF

Goods and Services IC 014. US 002 027 028 050. G & S: Beads for making jewelry; Body jewelry; Bracelets; Broaches; Bronze jewelry; Brooches; Cameos; Charms for collar jewelry and bracelet; Children's jewelry; Clasps for jewelry; Costume jewelry; Ivory jewelry; Jewelry; Jewelry boxes; Jewelry chains; Jewelry dishes; Jewelry ornaments; Jewelry ring holders; Jewelry watches; Key chains as jewelry; Lapel pins; Necklaces; Pins being jewelry; Rings; Rings being jewelry; Slap bracelets; Watch bracelets; Women's jewelry; Wooden bead bracelets. FIRST USE: 20150303. FIRST USE IN COMMERCE: 20150303

IC 025. US 022 039. G & S: Aqua shoes; Ballet shoes; Boat shoes; Chef's hats; Cycling shoes; Dance shoes; Deck-shoes; Dress pants; Dress shirts; Dress straps; Dress suits; Dresses; Drivers; Evening dresses; Football shoes; Fur hats; Golf shoes; Hat bands; Hats; Knit skirts; Leather shoes; Leather skirts; Leisure shoes; Men's dress socks; Neck scarfs; Rain hats; Scarfs; Skirt suits; Tennis dresses; Travel clothing contained in a package comprising reversible jackets, pants, skirts, tops and a belt or scarf; Woven dresses. FIRST USE: 20150304. FIRST USE IN COMMERCE: 20150304

Mark**Drawing Code** (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM**Serial Number** 86741406**Filing Date** August 29, 2015**Current Basis** 1A**Original Filing Basis** 1B**Published for Opposition** January 26, 2016**Registration Number** 5024031**Registration Date** August 16, 2016**Owner** (REGISTRANT) SHANGHAI SHENGMING INTERNATIONAL TRADE CO., LTD LIMITED LIABILITY COMPANY

CHINA ROOM459, Q ZONE, 4TH FLOOR, NO. 98, 901KANGYE ROAD, ZHUJIAJIAO TOWN, QINGPU
SHANGHAI CHINA 201700

Description of Mark Color is not claimed as a feature of the mark. The mark consists of seven letters "**Preself**", Letter "P " is capital with the rest letters "reself" in lower case.

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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Word Mark SOYA GIFT

Goods and Services IC 014. US 002 027 028 050. G & S: Bracelets; Earrings; Imitation jewellery; Jewellery; Jewellery cases; Jewellery chains; Jewelry ornaments; Necklaces; Paste jewelry; Pearls; Processed or semi-processed precious metals; Real and imitation jewellery; Rings; Straps for wristwatches; Wristwatches; Watches. FIRST USE: 20100702. FIRST USE IN COMMERCE: 20110602

IC 025. US 022 039. G & S: Clothing, namely, shirts, trousers, pants; headwear; Gloves as clothing; underclothing; underpants; Waterproof jackets and pants; caps; dresses; footwear; Hosiery; fur coats and jackets; Baby doll pyjamas; Pajamas; Bathing suits. FIRST USE: 20100702. FIRST USE IN COMMERCE: 20110602

Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search Code 05.15.25 - Other decorations made of plants
26.17.09 - Bands, curved; Bars, curved; Curved line(s), band(s) or bar(s); Lines, curved
29.01.07 - Inconspicuous designs functioning as punctuation or parts of letters; Small, inconspicuous design elements functioning as punctuation or parts of letters

Serial Number 86667820

Filing Date June 19, 2015

Current Basis 1A

Original Filing Basis 1A

Published for Opposition May 31, 2016

Registration Number 5020293

Registration Date August 16, 2016

Owner (REGISTRANT) Hu, Ying INDIVIDUAL CHINA Xian Nv Shan Renming Da Dao 284hao Bofa Ming Yuan 3-2-202 HanChuan City CHINA 432300

Attorney of Record Christopher Civil

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "GIFT" APART FROM THE MARK AS SHOWN

Description Color is not claimed as a feature of the mark. The mark consists of "SOYA GIFT" written in stylized form wherein

of Mark stylized crown like image is placed upon the letters "OYA" of the word "SOYA" and star like image is placed above the letter "I" of word "GIFT".

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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Soya Gifts







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| | |
|---------------------------------|---|
| Word Mark | PRR |
| Goods and Services | IC 014. US 002 027 028 050. G & S: clocks and watches. FIRST USE: 20160201. FIRST USE IN COMMERCE: 20160201 |
| | IC 025. US 022 039. G & S: shirts, hats, and jackets. FIRST USE: 20160201. FIRST USE IN COMMERCE: 20160201 |
| Mark Drawing Code | (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS |
| Design Search Code | 26.15.27 - Keystones |
| Serial Number | 86788690 |
| Filing Date | October 15, 2015 |
| Current Basis | 1A |
| Original Filing Basis | 1B |
| Published for Opposition | February 2, 2016 |
| Registration Number | 4990464 |
| Registration Date | June 28, 2016 |
| Owner | (REGISTRANT) Consolidated Rail Corporation CORPORATION PENNSYLVANIA 1717 Arch Street Suite 1310 Philadelphia PENNSYLVANIA 19103 |
| Attorney of Record | Kevin M. Bovard |
| Description of Mark | Color is not claimed as a feature of the mark. The mark consists of the stylized letters "PRR" superimposed over a keystone. |
| Type of Mark | TRADEMARK |

Register PRINCIPAL
Live/Dead Indicator LIVE

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